

**REMARKS**

**OBJECTIONS TO THE SPECIFICATION**

The Examiner has objected to the specification for allegedly failing to provide proper antecedent basis for the Claimed subject matter. The Examiner objects to the use of the phrase “the cavity” in Claims 6, 20, and 26 because the phrase is not detailed by the specification. Applicants have thus amended Claims 6, 20, and 26 (and all other Claims which use the term “cavity”) to replace “cavity” with “channel.” The term “channel” is described in the specification at Paragraph 20, for example. No new matter has been added. Applicants respectfully submit that the specification provides proper antecedent basis for Claims 6, 20, and 26-29, as amended.

**REJECTIONS UNDER 35 U.S.C. §112**

The Examiner has rejected Claims 1-30 as allegedly being indefinite or failing to particularly point out and distinctly Claim the subject matter which Applicants regard as the invention. In particular, the Examiner states that the term “cavity” in Claims 6, 20, and 26 is unclear.

As detailed above, Applicants have amended Claims 6, 20, and 26-29 to replace “cavity” with the term “channel.” Applicants believe that Claims 1-30 particularly point out and distinctly Claim the subject matter of the invention.

**ALLOWABLE SUBJECT MATTER**

The Examiner has indicated that Claim 31 is allowable and that Claims 9, 16, 22, and 25 would be allowable if rewritten to overcome the rejections under 35 U.S.C. §112 and to

include all of the limitations of the base Claim and any intervening Claims. Applicants have added new Claims 34, 35, 36, and 37 directed to the allowable subject matter of Claims 9, 16, 22, and 25. Applicants respectfully submit that these Claims are in condition for allowance.

**THE REJECTIONS UNDER 35 U.S.C. §102 SHOULD BE WITHDRAWN**

The Examiner has rejected Claims 1, 2, 5-10, 26, 30, 32, and 33 for allegedly being anticipated by U.S. Patent No. 4,637,085 to Hartkorn (“Hartkorn”).

Hartkorn discloses a joint spanning construction necessarily comprising a sealing body 2 and open-topped sills 3 and 4. (Hartkorn, col. 2, lines 9 to 51). The sealing body includes beading material 5 and 6 which is inserted into recesses defined by the open-topped sills and is secured within the sills by retainer bodies 20 and 21. Accordingly, the beading material necessarily includes a width and height sufficient to fill the open-topped sills. In operation, the multi-component joint system of Hartkorn is installed in a joint such that the outer edges of the sills are flush with a road surface. Hartkorn notes that the object of its invention, which is to provide ease of installing joint spanning constructions, is achieved by the joint spanning construction that includes open-topped sills having webs which extend into the beaded material. (Hartkorn col. 1, lines 49 to 56). Accordingly, Hartkorn does not disclose and never suggests that the sealing body alone is capable of functioning as a joint spanning construction. Indeed, the multi-component joint construction system comprising open-topped sills filled with beading material is the heart of Hartkorn’s invention.

Claim 1, as amended, recites, a compression seal comprising, among other things, “a lateral wing extending laterally from a top portion of the compressible sealing portion, the

lateral wing having a width and a height, the width being substantially larger than the height...”

Applicants submit that Hartkorn does not disclose or suggest a lateral wing having a width substantially greater than its height. Instead, and as detailed above, Hartkorn discloses and suggests a joint spanning construction including open-topped sills filled with beading material. Even assuming *arguendo* that the beading material constitutes a “lateral wing,” the “lateral wing” of Hartkorn does not have a width substantially larger than its height. Further, such a lateral wing construction is not suggested by Hartkorn as the beading material must have a width and a height sufficient to plug the open-topped sills. Indeed, the beading material of Hartkorn is not a “lateral wing,” but rather is filler material, as depicted in Figs. 1 and 2 of Hartkorn. Accordingly, Claim 1 is not anticipated by Hartkorn. Further, Hartkorn fails to suggest the compression seal of Claim 1. Applicant respectfully submits that Claim 1 is allowable over Hartkorn and the prior art of record. Additionally, Claims 2, 5-8, 10, and 26, each of which depend from Claim 1 are allowable for at least the aforementioned reasons.

Claim 32 recites a compression seal “*consisting of*” a compressible sealing portion and at least one lateral wing. *Emphasis Added*. It is well known that the term “consisting of” suggests that the compression seal of Claim 32 is devoid of additional components not recited in the Claim. Further, Claim 33 recites a compression seal “*consisting essentially of*” a compressible sealing portion and at least one lateral wing. *Emphasis Added*. The term “consisting essentially of” excludes additional components not recited in the Claim, provided that the additional components do not materially affect the basic and novel properties of the invention. As Hartkorn discloses a construction including at least (a) a sealing body

including beading material, (b) open topped sills; and (c) various retainer bodies, the construction of Hartkorn does not disclose or even suggest the compression seal of either of Claim 32 or Claim 33. For at least these reasons, Applicants respectfully submit that Claims 32 and 33 are in condition for allowance.

Applicants submit that new Claims 38 to 41 are also allowable over Hartkorn and the prior art of record. Particularly, Claim 38 recites, among other things, that the width of the lateral wing is substantially larger than the height of the lateral wing, and further that the height of the compressible sealing portion is substantially larger than the height of the lateral wing, while Claim 39 further recites that the lateral wing is configured to be received in a blackout region between adjacent elements. Hartkorn does not disclose or suggest such a construction. Indeed, the beading material of Hartkorn does not have a width that is substantially larger than its height since the dimensions of the beading material must be sufficient to fill the open-topped sills. Further, Hartkorn does not disclose or suggest that the beading material is configured to be received in a blackout region between adjacent element. Accordingly, Claims 38 and 39 are allowable over Hartkorn.

Further, new Claim 40 recites, among other things, that the compression seal is a one-piece construction. Hartkorn does not disclose or even suggest a one-piece construction. As described above, Hartkorn discloses a multi-component construction requiring at least the open-topped sills, sealing body with beading material, and retainer elements. Indeed, Hartkorn does not disclose or suggest that the sealing body is capable of functioning as a joint construction, as

suggested by the Examiner. Applicants respectfully submit that Claim 40 is allowable over Hartkorn.

Lastly, new Claim 41 recites an expansion joint system comprising, among other things, a compression seal, a lateral load bearing wing, and a blackout region disposed in the adjacent concrete elements. Hartkorn does not disclose a expansion joint spacing between adjacent concrete elements, nor does it disclose or suggest a blackout region adapted to receive a lateral load-bearing wing. Accordingly, Applicants submit that new Claim 41 is allowable over Hartkorn.

No new matter has been added as support for the subject matter of each of the new Claims 38 to 41 is located throughout the specification and in particular in Figures 1 to 6.

**THE REJECTIONS UNDER 35 U.S.C. §103 SHOULD BE WITHDRAWN**

The Examiner has rejected Claims 3 and 4 as allegedly being unpatentable over Hartkorn in view of U.S. Patent No. 5,213,441 to Baerveldt ("Baerveldt '441"). Baerveldt '441 discloses a multi-part, multi-material expansion joint seal system, including a protective retainer element to be bolted to cement slabs as a means of retaining and protecting a separate seal element. (Baerveldt, '441, col. 1, lns. 59-66).

Neither Hartkorn nor Baerveldt '441 disclose or suggest a lateral wing extending laterally from a top portion of the compressible sealing portion and having a width being larger than its height, as recited in Claim 1, from which Claims 3 and 4 depend. For at least this reason, Applicants believe that Claims 3 and 4 are in condition for allowance.

The Examiner has also rejected Claims 11-15, 19-21, 23, and 25 as allegedly being unpatentable over U.S. Patent No. 5,584,152 to Baerveldt (“Baerveldt ‘152”) in view of Hartkorn. Baerveldt ‘152 discloses an expansion joint comprising a seal element 11 and joint seal retaining elements 14. (Baerveldt ‘152, Fig. 3). In particular, the seal element 11 includes a central body which spans a joint cut or formed in a surface, and which further includes side flaps which extend from the central body portion at an intermediate point. The side flaps lie flat in the channels formed in the cut out surface and retaining elements 14 are utilized to overlie the side flap members. The multi-component construction of Baerveldt is secured by a bolt.

Baerveldt ‘152 does not disclose or suggest a compression seal comprising a “lateral wing extending laterally from a top portion of the compressive seal portion,” as recited in amended Claim 11. As mentioned above and depicted in Fig. 3, each of the side flaps of Baerveldt extend from an intermediate point of the seal element. As described above and depicted in Fig. 3, each of the retaining elements 14 overlie each side flap such that each retaining element has a top surface that is flush with the concrete surface. Indeed, Baerveldt ‘152 does not disclose a joint expansion system which includes a lateral wing extending laterally from a top portion of the compressible seal. Moreover, Baerveldt ‘152 actually teaches away from such construction because side wings extending laterally from a top portion of Baerveldt’s central body would interfere with the placement of the retaining elements as well as maintaining that the retaining elements are flush with the concrete surface.

Further, there is no suggestion or motivation in the art (or within Baerveldt ‘152 or Hartkorn for that matter) to combine Baerveldt ‘152 with Hartkorn, and have an expectation

of success. Even assuming *arguendo* that the beading material of Hartkorn is “a lateral wing extending laterally from a top portion of a compressible seal,” one motivated in the art would not combine such lateral wing construction with the central body of Baerveldt ‘152. Such construction would interfere with the retaining elements as discussed above. Thus, Baerveldt ‘152 and Hartkorn, alone or in combination, do not render obvious Claim 11 nor dependent Claims 12-15, 19-21, 23 and 25. Applicants respectfully submit that for at least these reasons, Claim 11 and dependent Claims 12-15, 19-21, 23, and 25 are in condition for allowance.

The Examiner has rejected dependent Claims 17 and 18 as allegedly being unpatentable over Baerveldt ‘152 in view of Hartkorn and Baerveldt ‘441. As mentioned above, Baerveldt ‘152 and Hartkorn alone or in combination do not disclose or suggest the expansion joint system of Claim 11. Moreover, Baerveldt ‘441 does not remedy the deficiencies of either Baerveldt ‘152 or Hartkorn. At least for the reasons that Claim 11 is allowable, so are dependent Claims 17 and 18. Applicants respectfully submit that for at least these reasons, Claims 17 and 18 are in condition for allowance.


Lastly, new Claims 39 to 41 are allowable over Baerveldt ‘152 and the prior art of record. In particular, each of new Claims 39 to 41 recite, among other things, a “lateral wing extending laterally from a top portion of the compressible sealing portion.” As discussed above, Baerveldt teaches away from such a construction. Applicants respectfully submit that new Claims 39 to 41 are allowable over the prior art of record.

**CONCLUSION**

In light of the foregoing, Applicants respectfully submit that pending Claims 1-41 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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